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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,592	02/12/2001	Beverly M. Emerson	1211.003US1	1304

7590

10/02/2002

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EXAMINER

WHITEMAN, BRIAN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 10/02/2002

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,592

Applicant(s)

EMERSON, BEVERLY M.

Examiner

Brian Whiteman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-88 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 38-88 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7-24-01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims 38-88 are pending.

Upon further consideration of the amended claims in paper no. 9, the amended claims require a restriction because the chromatin remodeling complexes in claims 44 and 52 are independent and distinct and it would be an undue burden on the examiner to search the prior art for the entire breadth of the claimed embodiment. Thus the rejections set forth in the Non-Final Rejection, paper no. 6, are vacated.

Thus, amended claims 38-88 are subject to the following restriction.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 38-51, 53-61, 63-77, 79-85, and 87-88, drawn to a method to identify a test compound that modulates chromatin remodeling of a specific DNA sequence with a chromatin, wherein the chromatin remodeling complex is SWI/SNF or ISWI, classifiable in class 424, subclass 9.1.
- II. Claims 38-43, 52, 54-61, 63-69, 78, 80-85, and 87-88, drawn to a method to identify a test compound that modulates chromatin remodeling of a specific DNA sequence with a chromatin, wherein the chromatin remodeling complex is RSC, classifiable in class 424, subclass 9.1.
- III. Claims 38-43, 52, 54-61, 63-69, 78, 80-85, and 87-88, drawn to a method to identify a test compound that modulates chromatin remodeling of a specific DNA sequence with a chromatin, wherein the chromatin remodeling complex is NURF, classifiable in class 424, subclass 9.1.

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- IV. Claims 38-43, 52, 54-61, 63-69, 78, 80-85, and 87-88, drawn to a method to identify a test compound that modulates chromatin remodeling of a specific DNA sequence with a chromatin, wherein the chromatin remodeling complex is CHRAC, classifiable in class 424, subclass 9.1.
- V. Claims 38-43, 52, 54-61, 63-69, 78, 80-85, and 87-88, drawn to a method to identify a test compound that modulates chromatin remodeling of a specific DNA sequence with a chromatin, wherein the chromatin remodeling complex is ACF, classifiable in class 424, subclass 9.1.
- VI. Claims 38-43, 52, 54-61, 63-69, 78, 80-85, and 87-88, drawn to a method to identify a test compound that modulates chromatin remodeling of a specific DNA sequence with a chromatin, wherein the chromatin remodeling complex is NURD, classifiable in class 424, subclass 9.1.
- VII. Claims 38-43, 52, 54-61, 63-69, 78, 80-85, and 87-88, drawn to a method to identify a test compound that modulates chromatin remodeling of a specific DNA sequence with a chromatin, wherein the chromatin remodeling complex is RSF, classifiable in class 424, subclass 9.1.
- VIII. Claims 62 and 86, drawn to a test compound identified by the method of claim 38 or 63, classifiable in class 530, subclass 350, class 536, subclass 23.1.

Claim 38 and 63 link(s) inventions I-VII. The restriction requirement between the linked inventions is subject to the non-allowance of the linking claim(s), claims 38 and 63. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the

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allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because:

Inventions VIII and I-VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the test compound in invention VIII identified by any method in Groups I-VII can be a compound (e.g. polynucleotide sequence, organic compound, peptide, polypeptide, antibody) and these compounds are distinct compounds with distinct structures and functions and could be used in a therapeutic method for genetic diseases, wherein said method comprises inhibiting or enhancing the interaction of the subunit of the chromatin remodeling complex and the domain within the protein. In addition, the different classification of each invention further displays that it would be an undue burden on the examiner to search the entire claimed invention because each group requires a different search.

As set forth in *In re Harnisch* (631F.2d 716 206 USPQ 300 (CCPA 1980)), see MPEP 803.02, unity of invention exists for all species in a claim (1) shows a common utility, and (2) share a substantial structural feature disclosed as being essential to that utility.

In view of *In re Harnisch*, claims 38-61, 63-85, 87-88 lack unity of invention for the following reasons: 1) chromatin remodeling complex (SWI/SNF, ISWI or as recited in the group of claim 52 or 78). The chromatin remodeling complex SWI/SNF does not share a substantial structural feature disclosed as being essential for that utility with the other chromatin remodeling complexes listed in the claimed invention. SWI/SNF and ISWI share a substantial structural feature (subunits), however, the subunits for the other remodeling complexes recited in claim 52 or 78 are unknown and do not share a substantial structural feature with the SWI/SNF or ISWI. In addition, the specification teaches that there are seven chromatin-remodeling complexes and several properties indicate that these complexes are functionally and mechanistically distinct (page 3 of the specification). Therefore in view of *In re Harnisch*, claims 38-61, 63-85, and 87-88 lack unity of invention and are separated into distinct groups as shown in Groups I-VII.

Although there are no provisions under the section for "Relationship of Inventions" in MPEP 806.05 for inventive groups that are directed to different methods, restriction is deemed to be proper because MPEP 802.01 states, "35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application." Each of the methods of inventions I-VII constitutes patentably distinct inventions for the following reasons: Each of the inventions is directed to different goals and comprises materially distinct steps, wherein each of the compositions in each invention is structurally distinct and/or generates distinct mechanisms and functional effects.

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The scope of each of the cited inventions encompasses an employed method, which generates distinct function(s) and effect(s), and furthermore does not necessarily overlap with that of another invention. The specification teaches that there are seven chromatin-remodeling complexes and several properties indicate that these complexes are functionally and mechanistically distinct (page 3 of the specification). Inventions I-VII comprise materially distinct steps, and/or generate different functions and effects and is not required for use with one another. Therefore the invention of groups I-VII are distinct.

Because these inventions are distinct for the reasons given above and the search required for each group is not required for the other groups, restriction for examination purposes as indicated is proper.

It would be unduly burdensome for the examiner to search and consider patentability of all of the presently pending claims, a restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 § 1.17(h).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kay Pinkney whose telephone number is (703) 305-3553.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Whiteman whose telephone number is (703) 305-0775. The examiner can normally be reached on Monday through Friday from 8:00 to 5:00 (Eastern Standard Time), with alternating Fridays off.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's mentor, primary examiner, Dave Nguyen can be reached at (703) 305-2024.

If attempts to reach the primary examiner by telephone are unsuccessful, the examiner's supervisor, John L. LeGuyader, SPE - Art Unit 1635, can be reached at (703) 308-0447.

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center number is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Brian Whiteman
1635
9/30/02



DAVE T. NGUYEN
PRIMARY EXAMINER